

Remarks

The above Amendments and these Remarks are in reply to the Office Action mailed May 10, 2007. A Petition for Extension of Time is submitted herewith, together with the appropriate fee. Also included with this Response are declarations under 37 C.F.R. § 1.132, signed by each inventor of the present Application.

I. Interview Summary

On August 2, 2007, Applicant conducted an interview with the Examiner to discuss the claim rejections under 35 U.S.C. § 102(a). During the interview, Applicant and Examiner discussed the reference California Energy Commission, "Conceptual Design Energy Analysis Tool (CDEAT) Research & Development – Final Report," June 2002 (hereinafter Final Report reference) and the possibility of an affidavit under 37 C.F.R. 1.132 to remove the Final Report reference as prior art. Applicant agreed to submit the affidavits under 37 C.F.R. § 1.132, which are included along with this Response.

Further, Applicant and Examiner discussed the rejections under 35 U.S.C. § 101 and Applicant agreed to amend Claims 140 and 141 in accordance with Examiner's suggestions, so as to more clearly define the statutory subject matter of these claims under 35 U.S.C. § 101.

Further, Applicant and Examiner discussed several minor errors that have occurred in the re-numbering of claims on page 2 of the Office Action. More specifically, the correct numbers of currently pending claims should be 1, 3-15, 17-31, **33**-57, 59-85, 87-171 and **173**-196. These claims should be re-numbered as Claims 1-190. For clarity, the present Response maintains the original numbering of the claims, as filed.

II. Summary of Rejections in the Office Action

In the Office Action mailed May 10, 2007, Claims 1, 3-15, 17-31, 34-57, 59-85, 87-171 and 174-196 were renumbered as Claims 1, 2-14, 15-29, 30-53, 54-80, 81-165 and 166-188 respectively. Therefore Claims 1-188 are currently pending in the Application. In the Office Action, Claims 4, 9, 10, 11, 17, 20, 24, 25, 26, 37, 38, 39, 45, 48, 52, 60, 65, 66, 67, 73, 76, 80, 96, 97, 98, 110, 111, 114, 119, 120, 122, 129, 133, 134, 138, 144, 149, 150, 151, 157, 160, 164, 177, 178, 179, 185, 188 and 192 were interpreted as reciting a non-positive limitation which does not distinguish the claimed element from the prior art. Claims 140-168 were rejected under 35

U.S.C. § 101 as being directed to non-statutory subject matter. Claims 29-31, 34-52, 85, 87-102, 126-164, 169-171 and 174-192 were rejected under 35 U.S.C. § 102(a) as being anticipated by California Energy Commission, "Conceptual Design Energy Analysis Tool (CDEAT) Research & Development – Final Report, June 2002 (hereinafter Final Report). Claims 103-105 and 114-115 were rejected under 35 U.S.C. § 102(e) as being anticipated by Ananian et al. (U.S. Patent No. 6,922,701, hereinafter Ananian). Claims 116-125 were rejected under 35 U.S.C. § 102(e) as being anticipated by Shanahan et al. (U.S. Publication No. 2005/0022114, hereinafter Shanahan). Claims 1, 3-15, 17-24, 57 and 59-80 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Final Report in view of Hong et al. "Building simulation: an overview of developments and information sources", Elsevier Science, 2000 (hereinafter Hong) and in view of Shanahan. Claims 25, 26, 28, 81, 82 and 84 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Final Report in view of Hong in view of Shanahan and further in view of Lam et al. "Distributed Web-Based Building Performance Computing: A Singapore-U.S. Collaborative Effort", Seventh International IBPSA Conference, August 13-15, 2001. Claims 27 and 83 were rejected under 35 U.S.C. 103(a) as being unpatentable over Final Report in view of Hong, in view of Shanahan and further in view of Ananian. Claims 53-54, 56, 165-166, 168, 193-194 and 196 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Final Report in view of Hong and in view of Lam. Claims 55, 167 and 195 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Final Report in view of Hong and in view of Ananian. Claims 106-113 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ananian in view of Final Report.

III. Summary of Applicant's Amendment

The present Response amends Claims 1, 4-5, 7, 9, 10-12, 17-20, 24-26, 29, 33, 35, 37-40, 45-48, 52-54, 60-61, 63, 65-68, 73-76, 80-82, 88, 91-92, 94, 96-99, 103-104, 108, 110-112, 114, 116, 119-120, 122, 126, 129, 132-134, 137-138, 140-141, 144-145, 147, 149-152, 157-160, 164-166, 169, 173, 175, 177-180, 185-188 and 192-193, leaving for the Examiner's present consideration pending Claims 1, 3-15, 17-31, 33-57, 59-85, 87-171 and 173-196. The present Response also includes declarations under 37 C.F.R. § 1.132 signed by each inventor of the present Application. Reconsideration of the Application, as amended, is respectfully requested.

IV. Claim Interpretation

In the Office Action mailed May 10, 2007, Claims 4, 9, 10, 11, 17, 20, 24, 25, 26, 37, 38, 39, 45, 48, 52, 60, 65, 66, 67, 73, 76, 80, 96, 97, 98, 110, 111, 114, 119, 120, 122, 129, 133, 134, 138, 144, 149, 150, 151, 157, 160, 164, 177, 178, 179, 185, 188 and 192 were interpreted as reciting a non-positive limitation “can include,” which does not distinguish the claimed element from the prior art, but only requires the ability to so include.

The present Response hereby amends each of the above cited claims so as to remove the “can include” element and to more clearly and positively define the embodiments therein. Applicant respectfully submits that as amended, the Claims no longer contain non-positive limitations.

V. Claim Rejections under 35 U.S.C. § 101

In the Office Action mailed May 10, 2007, Claims 140-168 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. More specifically, the preamble of the independent Claims 140 and 141 are directed towards a system however the body of the claim is directed towards software per se.

The present Response hereby amends independent Claims 140 and 141 so as to more clearly define the statutory subject matter of the embodiments therein. Applicant respectfully submits that as amended, Claims 140-168 now comply with the requirements of 35 U.S.C. § 101 and reconsideration thereof is respectfully requested.

VI. Claim Rejections under 35 U.S.C. § 102(a)

In the Office Action mailed May 10, 2007, Claims 29-31, 34-52, 85, 87-102, 126-164, 169-171 and 174-192 were rejected under 35 U.S.C. § 102(a) as being anticipated by California Energy Commission, “Conceptual Design Energy Analysis Tool (CDEAT) Research & Development – Final Report, June 2002 (hereinafter Final Report).

The present Response hereby includes declarations under 37 C.F.R. § 1.132 signed by each inventor of the present Application and each author of the Final Report reference, John F. Kennedy, Thomas P. Conlon, Patrick J. Bailey, Matthew P. Gangemi, Shin-ta Huang and Eliot D. Hance. The declarations clearly state that the subject matter disclosed in the Final Report

reference was invented by John F. Kennedy, Thomas P. Conlon, Patrick J. Bailey, Matthew P. Gangemi and Shin-ta Huang (par. #2), all of who are also listed as inventors in the present Application. Therefore, the Final Report reference discloses the Applicants' own prior work published within 1 year of the effective filing date of the application and thus is not an invention "by another" under 35 U.S.C. § 102(a). (See MPEP § 2132.01 "Applicant's disclosure of his or her own work within the year before the application filing date cannot be used against him or her under 35 U.S.C. § 102(a).") Accordingly, Applicant respectfully requests that the Final Report reference be disqualified as prior art against the present application.

VII. Claim Rejections under 35 U.S.C. § 102(e)

In the Office Action mailed May 10, 2007, Claims 103-105 and 114-115 were rejected under 35 U.S.C. § 102(e) as being anticipated by Ananian et al. (U.S. Patent No. 6,922,701, hereinafter Ananian). Claims 116-125 were rejected under 35 U.S.C. § 102(e) as being anticipated by Shanahan et al. (U.S. Publication No. 2005/0022114, hereinafter Shanahan).

Claim 103

Claim 103 has been amended to more clearly define the embodiment therein. As amended, Claim 103 currently defines:

103. A method for allowing a user to interact with content including product and service advertisements or product placement on building instance for analysis, using a computer network, comprising:
automatically providing the content to the user based on a set of criteria associated with the building characteristics including its energy use information and wherein at least one of the criteria is satisfied based on a representation of a building and results of an energy analysis of the representation of the building;
allowing the user to interact with the content; and
wherein the interaction results in at least one of: 1) a request for information; 2) a request for a bid; 3) permission to access information associated with the user; 4) providing permission to access information associated with the representation of the building and/or results of the energy analysis.

As amended, Claim 103 specifically defines a criteria that is satisfied based on building energy use information and the results of energy analysis of the representation of the building. Ananian is insufficient to disclose conducting any energy use calculations of a building, as

defined in Claim 103. Thus, Ananian fails to disclose a criteria that is satisfied based on the results of an energy analysis of the representation of the building, as specifically defined in Claim 103.

This feature of Claim 103 allows advertisements and other information to be provided to the user based on the energy analysis results. No energy analysis is performed in Ananian. Instead, Ananian discloses that the user is required to request an item including bids and bids are for work to be completed on a building. The bids are not for advertising, product placement, or product energy analysis on the building design, which is specific to Claim 103.

Further, Claim 103 defines that users are automatically presented pre-qualified items to the user. This feature does not require a request from the user, as is the case in the Ananian reference. In view of the above comments, Applicant respectfully submits that Ananian fails to anticipate the features of Claim 103 and reconsideration thereof is respectfully requested.

Claim 116

Claim 116 has been amended to more clearly define the embodiment therein. As amended, Claim 116 defines:

*116. A method for generating a qualified result list based on a building representation and using a computer network, comprising:
maintaining a database of at least one information provider, wherein each of the at least one information providers has associated with it a set of building criteria and content;
identifying a result set of the at least one information providers that have criteria at least partially satisfied by the building representation and an energy analysis of the building representation;
ranking the information providers in the result set into a result list; and
providing content via the computer network corresponding to at least the highest ranked information provider in the result list.*

As such, Claim 116 identifies the result set of information providers based on the energy analysis of the building representation. This energy analysis is unique and is difficult to achieve in an automated fashion. Shanahan fails to disclose this feature of Claim 116.

Instead, Shanahan appears to describe a personality identifier for a physical object. The personality identifier is associated with a data document that contains various information. There is a query performed and based on the information, the results are filtered and ranked. For example, the personality of a building structure may have the building codes, images, history,

etc. However, Shanahan is not concerned with performing any energy analysis of a building representation, as defined in Claim 116. As such, Shanahan fails to anticipate this feature of Claim 116.

Claims 104-105, 114-115 and 117-125

Claims 104-105, 114-115 and 117-125 are not addressed separately, but it is respectfully submitted that these claims are allowable as depending from an allowable independent claim, and further in view of the comments provided above. Applicant respectfully submits that these Claims are similarly neither anticipated by, nor obvious in view of the cited references, and reconsideration thereof is respectfully requested.

It is also submitted that these claims also add their own limitations which render them patentable in their own right. Applicant respectfully reserves the right to argue these limitations should it become necessary in the future.

VIII. Claim Rejections under 35 U.S.C. § 103(a)

In the Office Action mailed May 10, 2007, Claims 1, 3-15, 17-24, 57 and 59-80 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Final Report in view of Hong et al. "Building simulation: an overview of developments and information sources", Elsevier Science, 2000 (hereinafter Hong) and in view of Shanahan. Claims 25, 26, 28, 81, 82 and 84 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Final Report in view of Hong in view of Shanahan and further in view of Lam et al. "Distributed Web-Based Building Performance Computing: A Singapore-U.S. Collaborative Effort", Seventh International IBPSA Conference, August 13-15, 2001. Claims 27 and 83 were rejected under 35 U.S.C. 103(a) as being unpatentable over Final Report in view of Hong, in view of Shanahan and further in view of Ananian. Claims 53-54, 56, 165-166, 168, 193-194 and 196 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Final Report in view of Hong and in view of Lam. Claims 55, 167 and 195 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Final Report in view of Hong and in view of Ananian. Claims 106-113 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ananian in view of Final Report.

In view of the declaration under 37 C.F.R. § 1.132 submitted herewith, and further in view of the comments above (section V), Applicant respectfully submits that the Final Report

reference does not constitute proper prior art against the present Application under 35 U.S.C. §102. Furthermore, because the Final Report reference was relied upon in the rejections under 35 U.S.C. § 103(a), Applicant respectfully submits that these rejections should also be withdrawn in light of the declaration under 37 C.F.R. § 1.132.

IX. Conclusion

In view of the above amendments and remarks, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and reconsideration thereof is respectfully requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including November 7, 2007.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: November 7, 2007

By: /Justas Geringson/

Justas Geringson
Reg. No. 57,033

Customer No.: 23910
FLIESLER MEYER LLP
650 California Street, 14th Floor
San Francisco, California 94108
Telephone: (415) 362-3800
Fax: (415) 362-2928